

**REMARKS/ARGUMENT**

The Applicants respond under 37 C.F.R. § 1.111 to the Office Action of April 28, 2010.

Claims 1 through 22 are pending in the application. Claims 11 through 18 are canceled.

Claims 1 through 10 and 19 through 22 are amended. New claims 23 and 24 are added.

Initially, the Applicants wish to call the Examiner's attention to co-pending U.S. Patent Application Serial No. 10/587,802, which is directed to a similar, but patentably distinct, invention.

**1. Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 1 through 11 and 19 through 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as their invention. According to the Examiner:

(1) Independent claim 1 and several other dependent claims recite component (a) as a pyridylethylbenzamide derivative of "general formula (I)" (emphasis added). The term "general" renders the claim indefinite because it is not clear whether the formula given in claim 1 is merely one general possibility, i.e. the claims are open to other pyridylethylbenzamides that do not have the structure of formula (I).

The term "general" no longer appears in any of the pending claims.

(2) At line 14 of claim 1, 'as to the N-oxides of 2-pyridine thereof' is unclear, grammatically incorrect, and lacks antecedent basis.

The phrase "as to the N-oxides of 2-pyridine thereof" is amended to read "and to the N-oxides of the 2-pyridine moiety thereof." It is respectfully submitted that the modified language is clear and grammatically correct and has antecedent basis in the structural formula (I) itself.

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(3) In claim 10, the term ‘triazole derivative’ is indefinite. The term ‘derivative’ can have multiple meanings, with almost no limit as to how far a compound can be derivatized from a starting triazole ring structure, e.g. ring opening/cleavage. One skilled in the art would not understand with sufficient clarity whether a given compound would or would not be within the metes and bounds of the claim term, ‘triazole derivative.’

Claim 10 is now amended to incorporate therein the Markush group that was formerly in claim 11, and claim 11 is canceled. Thus, one skilled in the art, reading amended claim 10, will easily understand with sufficient clarity whether a given compound would or would not be within the metes and bounds of the claim term “triazole derivative.”

(4) Merely reciting another fungicide as ‘a fungicidal compound (c)’ is confusing and indefinite since one skilled in the art cannot possibly know, without more, what would qualify a compound as a ‘(c)’ compound.

Claim 19 is now amended to be directed to fungicidal compounds (c) that are different from (a) and (b) and selected from a specific Markush group, the members of which will be familiar to persons of ordinary skill in the art.

(5) Improper Markush language is used in claim 20. Correct language is ‘selected from the group consisting of ... and [last member].’

Claim 20 is amended to incorporate conventional Markush language.

(6) In claim 20, many of the (c) fungicides are triazoles, e.g. tebuconazole. So it is confusing to recite a component (b) again as a component (c).

Claim 20 is dependent upon claim 19. As noted above, claim 19 is now amended to be directed to fungicidal compounds (c) that are different from (a) and (b). Therefore, although a compound (c) may also appear in a listing of compounds that can be used as the (b) component, according to

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claims 19 and 20, there must be a (b) component and a (c) component that are not the same compounds.

Accordingly, it is requested that the rejection of claims 1 through 11 and 19 through 22 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**2. Rejection under 35 U.S.C. § 103(a)**

Claims 1 through 11 and 19 through 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of WO 2004/016088 in view of Holmwood et al. (U.S. Patent No. 4,723,984) in view of Hopkinson et al. (U.S. Patent No. 6,746,988). The Applicants traverse this rejection and request reconsideration.

**STATEMENT CONCERNING COMMON OWNERSHIP**

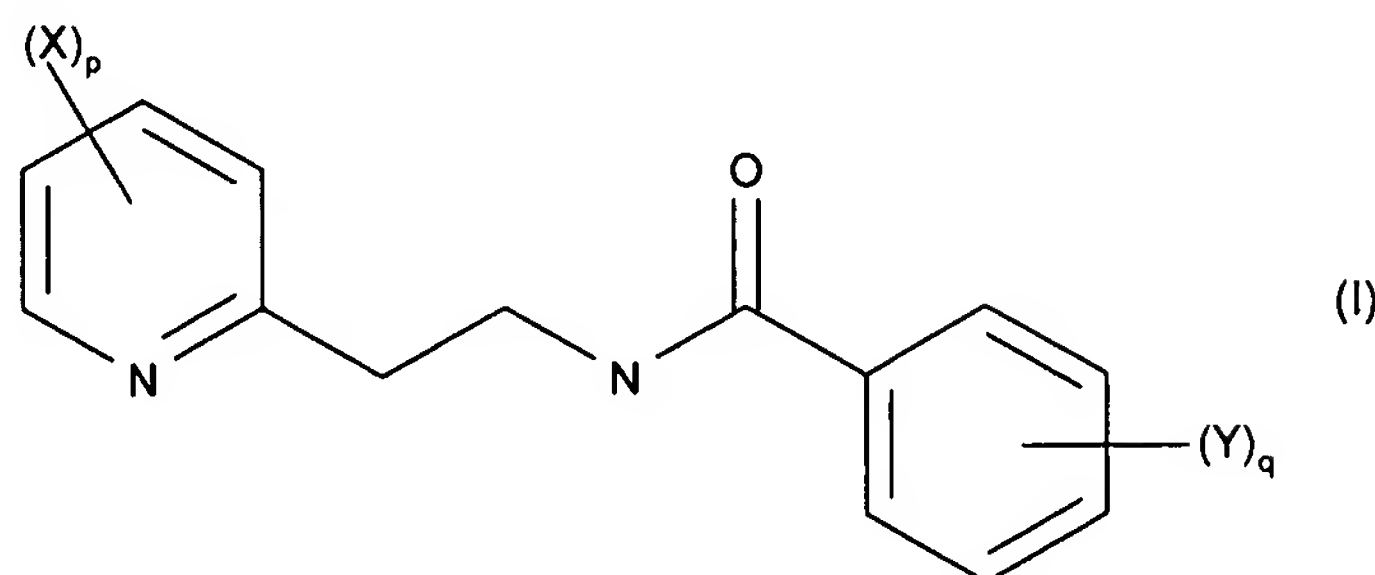
The undersigned, the Applicants' attorney of record, states that at the time the invention of the present application was made, this application and Mansfield et al. (WO 2004/016088) were both owned by BAYER CROPSCIENCE S.A. of 16 Rue Jean-Marie LeClair, F-69009 Lyon, France.

Accordingly, it is submitted that Mansfield et al. (WO 2004/016088) is unavailable as a reference against the patentability of the present invention under 35 U.S.C. § 103(c).

If, in what is deemed the unlikely event the U.S. Patent and Trademark Office should determine that 35 U.S.C. § 103(c) is inapplicable here, the Applicants alternatively offer the following arguments in support of the patentability of the present claims over the cited art.

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Mansfield et al. disclose compounds of general formula I,



in which p is an integer equal to 1, 2, 3 or 4; q is an integer equal to 1, 2, 3, 4 or 5; each substituent X is chosen, independently of the others, as being halogen, alkyl or haloalkyl, at least one of the substituents being a haloalkyl; each substituent Y is chosen, independently of the others, as being halogen, alkyl, alkenyl, alkynyl, haloalkyl, alkoxy, amino, phenoxy, alkylthio, dialkylamino, acyl, cyano, ester, hydroxy, aminoalkyl, benzyl, haloalkoxy, halosulphonyl, halothioalkyl, alkoxyalkenyl, alkylsulphonamide, nitro, alkylsulphonyl, phenylsulphonyl or benzylsulphonyl; as to the N-oxides of 2-pyridine thereof; with the exception of N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]-ethyl}-2,6-dichlorobenzamide.

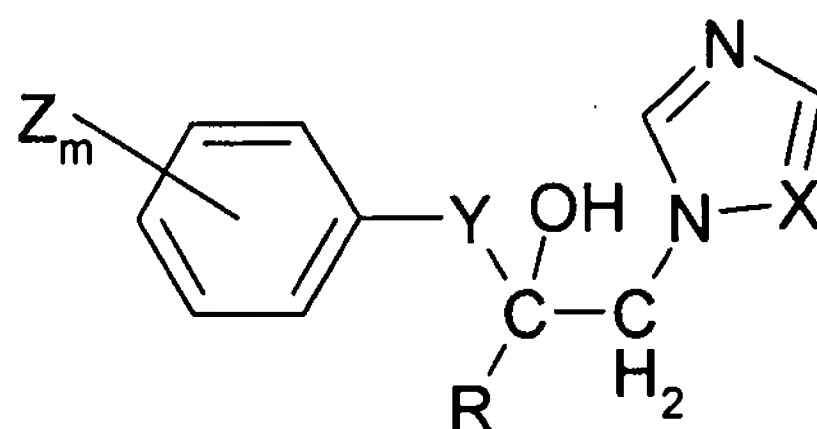
The Applicants acknowledge that pyridylethylbenzamide derivatives employed in the practice of the present invention are within the scope of this Mansfield et al. disclosure. The Applicants also acknowledge that Mansfield et al. disclose:

The compounds of the invention can also be mixed with one or more insecticides, fungicides, bactericides, attractant acaricides or pheromones or other compounds with biological activity. The mixtures thus obtained have a broadened spectrum of activity: The mixtures with other fungicides are particularly advantageous.

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However, there is no teaching or suggestion in Mansfield et al. of any synergistic effect obtained when such pyridylethylbenzamide derivatives are combined with compounds capable of inhibiting ergosterol biosynthesis, nor is there any disclosure of what the ratios of the two fungicides should be, such as the currently claimed (a)/(b) weight ratio of from 0.01 to 20.

Holmwood et al. disclose 1-hydroxyethyl-azole derivatives of the general formula



in which  $R$  represents an alkyl radical, an optionally substituted cycloalkyl radical or an optionally substituted phenyl radical,  $X$  represents a nitrogen atom or a  $CH$  group,  $Y$  represents a grouping  $-OCH_2-$ ,  $-CH_2CH_2-$  or  $-CH=CH-$ ,  $Z$  represents a halogen atom, an alkyl, cycloalkyl, alkoxy, alkylthio, halogenoalkyl, halogenoalkoxy or halogenoalkylthio radical, an optionally substituted phenyl radical, an optionally substituted phenoxy radical, an optionally substituted phenylalkyl radical or an optionally substituted phenylalkoxy radical, and  $m$  is 0, 1, 2, or 3; a process for their preparation; and their use as plant growth regulators and fungicides.

The invention of Holmwood et al. is primarily directed to the 1-hydroxyethyl-azoles, *per se*, and their use as plant growth regulators, although the patentees do show fungicidal activity against a fungus, but only one: *Erysiphe graminis f.sp. hordei*. The Applicants

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acknowledge that the compositions of the present invention can also be used against this fungus, as well as many others. Indeed, the Applicants acknowledge that the pyridylethylbenzamide derivatives and the triazole compounds used with them in the practice of the present invention are known fungicides.

The Examiner's position is understood to be that the pyridylethylbenzamide derivatives are known fungicides and the triazole compounds are known fungicides and, thus, it would be obvious to use them in combination.

It is the Applicants' position, however, that they have discovered a combination in a particular ratio that clearly exhibits synergism and is neither disclosed nor suggested by the cited art. They have demonstrated this synergism for this combination in the examples of the present specification, particularly Examples 1 through 10 and 16, using means for determining synergism that is accepted in the art, i.e., the Colby formula, which was published in the journal 15 WEEDS 20-22 (1967). The Examiner's attention is directed to U.S. Patent No. 6,753,339 in which the Colby method of determining synergism was also employed to the satisfaction of the Patent Office. In fact, the Applicants' representative searched the U.S. Patent and Trademark Office Patent Full-Text and Image Database using the keywords SPEC/Colby AND SPEC/synergism. A total of 214 hits were obtained. Clearly, the Colby method has been frequently used to the satisfaction of the Patent Office to shown synergism and, consequently, non-obviousness. Based on the teachings of the Mansfield et al. and Holmwood et al. references, skilled artisans might have expected fungicidal activity for mixtures of the pyridylethylbenzamide derivatives and the



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triazole compounds used with them in the practice of the present invention, but they would not have expected any synergy when associating these compounds, in particular, in the claimed weight ratio of from 0.01 to 20. Unexpected results have been shown for the claimed combination, and it logically follows that the combination cannot be obvious.

The Examiner, in the current Office Action, has gone to some lengths to dispute the reliability of the Colby method for showing synergism. It is noted, however, that the Examiner has not cited a single literature reference to support his position. It is submitted that this lack of support on the part of the Examiner places the Applicants at a disadvantage in that they cannot analyze and determine the applicability, if any, of any technology upon which the Examiner may be relying. It is respectfully requested that the Examiner either withdraw his objections to the Colby method or provide citations from reputable journals in support of his position.

Further, the Examiner has pointed out that Holmwood et al. disclose tebuconazole as a fungicide for protecting plants. It is acknowledged that the structural formula disclosed by Holmwood et al. reads on tebuconazole, *inter alia*, but that the only claim remaining in the current application that also reads on tebuconazole is claim 1. All of the other claims remaining in the application (2 through 10 and 19 through 22) read only on triazoles that do not have structures within the scope of the Holmwood et al. teaching.

Hopkinson et al. disclose surfactant systems comprising alkyl polyglycosides, anionic surfactants and basic compounds. Agricultural compositions comprising agriculturally active

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compounds, alkyl polyglycosides, anionic surfactants, and basic compounds are disclosed. The surfactant systems and agricultural compositions may further comprise nonionic surfactants.

Hopkinson et al. fail to supplement the deficiencies of Mansfield et al. and Holmwood et al. as references against the patentability of the subject invention, discussed above. At most, Hopkinson et al. teach that combinations of fungicides, some of which may or may not be triazoles, can be used in combination with surfactants. That this teaching is known in the art is also acknowledged. However, there is nothing in Hopkinson et al., alone or in combination with the other cited art, that would lead a person of ordinary skill in the art to prepare a composition comprising:

- (a) a pyridylethylbenzamide derivative of a specified formula and
- (b) a compound capable of inhibiting ergosterol biosynthesis;

in an (a)/(b) weight ratio of from 0.01 to 20. In fact, Hopkinson et al. disclose nothing at all about weight ratios of multiple fungicides or compounds that are capable of inhibiting ergosterol biosynthesis.

Accordingly, it is requested that rejection of claims 1 through 11 and 19 through 22 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of WO 2004/016088 in view of Holmwood et al. in view of Hopkinson et al. be withdrawn.



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In view of the foregoing, it is submitted that this application is in condition for allowance.

Favorable consideration is earnestly requested.

Respectfully submitted,



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